

ESTTA Tracking number: **ESTTA752614**

Filing date: **06/15/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Gabriel Engel
Granted to Date of previous extension	08/31/2016
Address	300 Rua Doutor Dario de Bittencourt#404B Porto Alegre, 92360-390 BRAZIL

Attorney information	Marie Anne Mastrovito Abelman Frayne & Schwab 666 Third Avenue New York, NY 10017 UNITED STATES mamastrovito@lawabel.com Phone:2129499022
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Applicant Information

Application No	86848870	Publication date	05/03/2016
Opposition Filing Date	06/15/2016	Opposition Period Ends	08/31/2016
Applicant	RocketDesk LLC 2120 Carey Ave., Suite 300 Cheyenne, WY 82001 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Downloadable computer software for instant messaging; Downloadable computer software for real-time customer support, customer service and customer engagement
Class 038. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Instant messaging services; Telecommunication services, namely, transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communication networks, and the Internet
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Software as a service (SAAS) services featuring software for instant messaging; Software as a service (SAAS) services featuring software for real-time customer support, customer service and customer engagement

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86898986	Application Date	02/05/2016
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ROCKET.CHAT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2015/05/19 First Use In Commerce: 2015/05/19 Downloadable computer software for instant messaging; Downloadable computer software for real-time customer support, customer service and customer engagement</p> <p>Class 038. First use: First Use: 2015/05/20 First Use In Commerce: 2015/05/20 Instant messaging services; Telecommunication services, namely, transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communication networks, and the Internet</p> <p>Class 042. First use: First Use: 2015/09/30 First Use In Commerce: 2015/09/30 Software as a service (SAAS) services featuring software for instant messaging; Software as a service (SAAS) services featuring software for real-time customer support, customer service and customer engagement</p>		

Attachments	86898986#TMSN.png(bytes) 0058_001.pdf(152983 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/MAM/
Name	Marie Anne Mastrovito
Date	06/15/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application No. 86/848870 for the mark ROCKETCHAT, Published May 3, 2016

GABRIEL ENGEL,

Opposer,

v.

ROCKETDESK LLC

Applicant

Opposition No.

NOTICE OF OPPOSITION

Gabriel Engel, an individual, citizen of Great Britain, with a business address at 300 Rua Doutor Dario de Bittencourt, Porto Alegre 92360-390, Brazil (“Opposer”), believes that he will be damaged by registration of the above identified trademark and hereby opposes the same.

As grounds for opposition it is alleged that:

1. On December 14, 2015, RocketDesk LLC (“Applicant”) filed an application seeking registration of the mark ROCKETCHAT (“Applicant’s Mark”), and said application was assigned Serial No. 86/848870 (hereinafter, “Applicant’s Application”).
2. Applicant’s Application covers the following goods and services: Downloadable computer software for instant messaging; downloadable computer software for real-time customer support, customer services and customer engagement, in Class 9; Instant messaging services; telecommunication services, namely, transmission of voice, data, graphics, images, audio and video by means of telecommunication networks, wireless communication networks; and the Internet, in Class 38; and Software as a service (SAAS) services featuring software for instant messaging; software as a service (SAAS) services featuring, software for real-time customer support, customer services and customer engagement, in Class 42 (“Applicant’s Goods and Services”).

3. The Applicant's Application is based on intention to use Applicant's Mark in commerce under Section 1(b) of the Trademark Act and, to date, Applicant has not filed a Statement of Use alleging use of Applicant's Mark in commerce.
4. Opposer is the owner of the all right, title and interest to the mark ROCKET.CHAT ("Opposer's Mark") in connection with downloadable computer software for instant messaging; downloadable computer software for real-time customer support, customer services and customer engagement; Instant messaging services; Telecommunication services, namely, transmission of voice, data, graphics, images, audio and video by means of telecommunication networks, wireless communication networks, and the Internet; and Software as a service (SAAS) services featuring software for instant messaging; software as a service (SAAS) services featuring, software for real-time customer support, customer services and customer engagement. ("Opposer's Goods and Services").
5. Opposer filed an application to register Opposer's Mark in connection with Opposer's Goods and Services on February 5, 2016. The Application was assigned Serial No. 86/898986 ("Opposer's Application").
6. Opposer's Application is based on Opposer's use of Opposer's Mark in commerce under Section 1(a) of the Trademark Act.
7. Opposer first commenced use of Opposer's Mark in U.S. commerce at least as early as May 19, 2015 and Opposer has used the mark continuously in U.S. commerce since the date of first use.
8. On information and belief, Applicant was not using Applicant's Mark in connection with any of Applicant's Goods and Services on or prior to May 19, 2015.
9. On information and belief, Opposer's first use of Opposer's Mark in U.S. commerce in connection with Opposer's Goods and Services was well in advance of both the filing date of Applicant's Application and any actual use Applicant's may have made of Applicant's Mark in U.S. commerce.

10. On May 23, 2016, the Examining Attorney reviewing Opposer's Application issued a provisional refusal to register Opposer's Mark based on an alleged likelihood of confusion with the Applicant's Mark as shown in Applicant's Application.
11. Registration of Applicant's Mark, which is highly similar to Opposer's Mark and which is intended for use in connection with goods and services which are closely related to Opposer's Goods and Services is likely to cause confusion, mistake, or deception of purchasers as to the source of Applicant's Goods and Services, and is likely to falsely suggest a common association, sponsorship or origin of said goods and services between Applicant and Opposer, all to Opposer's irreparable damage and injury.
12. In view of the foregoing, Applicant's use and registration of Applicant's Mark is likely to deceive and to cause mistake or confusion among members of the public as to the source of Applicant's Goods and Services within the meaning of Section 2(d) of the Trademark Act, and should be refused on this basis.

WHEREFORE, Opposer believes that it has a real interest in this proceeding and will be irreparably damaged by the registration of the Applicant's Mark, and respectfully requests that the Board sustain this Opposition and refuse the registration of the Applicant's Mark.

Respectfully submitted,


MARIE ANNE MASTROVITO

Attorney for Opposer

ABELMAN, FRAYNE & SCHWAB
666 Third Avenue
New York, New York 10017
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid, this 15th day of June, 2016 upon Applicant's Attorney:

Kristopher Koski
Long Reimer Winegar Beppler LLP
2120 Carey Avenue, Suite 300
Cheyenne, Wyoming 82001


MARIE-ANNE MASTROVITO